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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,885	06/27/2003	Robert Keane	MPJ-D1	7851
37420	7590	04/09/2008		
VISTA PRINT USA, INC. ATTN: PATENT COUNSEL 95 HAYDEN AVENUE LEXINGTON, MA 02421			EXAMINER GARCIA, GABRIEL I	
			ART UNIT	PAPER NUMBER
			2625	
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			04/09/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/608,885

**Applicant(s)**

KEANE ET AL.

**Examiner**

GABRIEL I. GARCIA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 AND 3-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## DETAILED ACTION

### *Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 © of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(c) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(c)).

2. Claims 1 and 3-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter et al. (7,124,302).

With regard to claim 1, Ginter et al. teaches a computer implemented method for creating an electronic product design (e.g. col. 302, lines 1-32), the method comprising: downloading (e.g. col. 25, lines 25-38) one or more product design software tools (e.g. col. 7, lines 5-37) the tools being adapted to execute in the browser of the user computer (e.g. col. 313, lines 15-31) and allow the user of the user computer to edit (or modify) (e.g. col. 32, lines 30-64) a downloaded product design template at the user computer to create a custom product design (e.g. col. 283, lines 13-35); providing a plurality of template images for viewing by the user of the user

computer (e.g. col. 283, lines 13-35) , the images representing electronic product design templates editable at the computer by the user (e.g. col. 32, lines 30-64 and col. 313, lines 15-31) , in response to the user's selection of one of the template image, downloading an editable product design template associated with the selected template image, the downloaded product design template being partially completed electronic product design (e.g. col. 302, lines 1-32, col. 25, lines 25-38, col. 7, lines 5-37 , col. 313, lines 15-31 and col. 32, lines 30-64) ; and allowing the user to use one or more of the tools to edit the downloaded template to incorporate at the user computer into the downloaded product design template to create a custom electronic product design at the user computer (e.g. col. 302, lines 1-32, col. 25, lines 25-38, col. 7, lines 5-37 , col. 313, lines 15-31 and col. 32, lines 30-64).

With regard to claim 3, Ginter et al. further teaches allowing the user to upload the electronic product design over a computer network to a server (e.g. col. 32, lines 25-48).

With regard to claim 4, Ginter et al. further teaches allowing the user to place an order for production of a quantity of a physical product corresponding to the electronic product design (e.g. col. 32, lines 30-55).

With regard to claim 5, Ginter et al. further teaches wherein the tools display the electronic product design to the user in WYSIWYG form (e.g. inherently reads on col. 23, lines 16-25).

With regard to claims 6-7, Ginter et al. further teaches allowing the user to modify at least one feature of the selected product design template or user content during the electronic product design process (e.g. col. 302, lines 1-32, col. 25, lines 25-38, col. 7, lines 5-37 , col. 313, lines 15-31 and col. 32, lines 30-64).

With regard to claim 8, Ginter et al. further teaches wherein the template images are displayed at a reduced size that allows a plurality of images to be simultaneously displayed to the user (e.g. **col. 23, lines 16-25, col. 302, lines 1-32, col. 25, lines 25-38, col. 7, lines 5-37 , col. 313, lines 15-31 and col. 32, lines 30-64**).

With regard to claim 16, Ginter et al. further teaches wherein the user is creating an electronic product design for another party (e.g. **reads on figs 49-50**).

With regard to claim 17, Ginter et al. further teaches wherein the other party provides product design information for use by the user in connection in creating the product design (**reads on figs 49-50 and col. 23, lines 35-65**).

With regard to claim 18, Ginter et al. further teaches wherein the other party provides at least some product design information via one or more electronic communications (**reads on figs 49-50 and col. 23, lines 35-65**).

With regard to claim 19, Ginter et al. further teaches wherein the other party provides at least some product design information via one or more voice communications (**reads on figs 49-50 and col. 23, lines 35-65**).

With regard to claim 20, Ginter et al. further teaches wherein the other party communicates directly with the user (**reads on figs 1-3 , which suggests that other party using the computer can directly connect to the service provide to submit a print order**) .

With regard to claim 21, Ginter et al. further teaches wherein the other party communicates with the user via one or more intermediate parties (**reads on figs. 1-3, depicts how the user can communicate to an intermediate distributor**).

With regard to claim 22, Ginter et al. further teaches wherein product design information provided by the other party comprises information identifying the type of product design by the other party (**reads on figs 1-3. 6, e.g. the product type is equivalent to the catalogs**).

With regard to claim 23, Ginter et al. further teaches wherein product design information provided by the other party comprises content that the other party desires be incorporated into an electronic product design (**reads on figs 1-3, the incorporation is being done by the imposition or editing**).

With regard to claims 24-25, Ginter et al. further teaches wherein the content comprises text or one or more graphic files (**reads on figs. 1-3, the different form having graphic**) .

With regard to claim 26, Ginter et al. further teaches comprising making the created electronic available to the other party (**see claim 16 above**).

With regard to claim 27, Ginter et al. further teaches wherein product design information provided by the other party comprises one or more requested modifications to the created electronic product design (**reads on figs. 1-3, the user can preview the information before submitting it, allowing the user to make any changes**).

With regard to claim 28, Ginter et al. further teaches wherein product design information provided by the other party comprises a request that the user create one or more new electronic designs (see figs. 1-15).

With regard to claim 29, Ginter al. further teaches wherein the product design information by the other party comprises the identification of one or more product design template (e.g. **col. 283, lines 13-35**).

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With regard to claim 30, Ginter et al. further teaches wherein the product design information provided by the other party comprises information describing one or more desired modifications to one or more of the one or more identified product design template (e.g. col. 283, lines 13-35).

With regard to claims 9-15 and 31-71, the limitations of claims 9-15 and 31-71 are covered by the limitations of claims 1-8 and 16-30 above. With regard to claims 70-71, Ginter et al. teaches the user select the features to create the design template creating the design, fig. 3, depict how the template file or preview layout file is stored in the user's computer that allow the user to design the final product and previewing it before submitting the request.

### *Conclusion*

3. Applicant's arguments with respect to the pre-appeal filed on 1/24/08 have been found to be persuasive. This office action is made **non-final**, in view newly found prior art.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The Central FAX Number for this group is 571-273-8300.

**CENTRALIZED DELIVERY POLICY:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

/Gabriel I Garcia/

Acting SPE of Art Unit 2625

**Gabriel I. Garcia**  
**Primary Examiner**  
**March 30, 2008**